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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,279	12/04/2003	David Arnes	03292.101730.1	7128
66569 7590 04/09/2008 FITZPATRICK CELLA (AMEX) 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
CHEUNG, MARY DA ZHI WANG				
ART UNIT		PAPER NUMBER		
3694				
MAIL DATE		DELIVERY MODE		
04/09/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/728,279

**Applicant(s)**

ARMES ET AL.

**Examiner**

MARY CHEUNG

**Art Unit**

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of the Claims***

1. This action is in response to the application filed on January 16, 2008. Claims 1-21 are pending. Claims 1, 7, 11-15 and 20 are amended. All pending claims are examined.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 7-8, 10-16 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al., US 5,815,657 in view of Randell et al., US 2004/0064375 A1.

As to claim 1, Williams teaches a method for identifying payment systems for facilitating the processing of payments, comprising (abstract):

- receiving from a user payment criteria for purchase of an item (column 15 lines 53-60);

- querying a directory of payment systems in an attempt to locate one or more payment systems to process the transaction based at least in part upon the payment criteria (column 20 line 61 – column 21 line 32 and Figs. 9-10); and
- returning an identification of the one or more located payment systems, if any, to process the transaction (column 31 lines 1-20 and Fig. 11).

Williams does not specifically teach including information indicating whether the located payment systems matched the payment criteria. However, this matter is taught by Randell as displaying level of match for payment criteria (§ 99 and claim 6 in page 10 and Fig. 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow William's teaching to include the matching information of payment criteria for allowing the user better track the payment status.

As to claim 2, Williams teaches interacting with the one or more located payment systems to at least partially process the transaction using the payment criteria (column 31 lines 1-20 and Figs. 11-12).

As to claim 3, Williams teaches the querying step includes selecting the one or more payment systems based upon attributes of the request for the transaction (column 20 line 61 – column 21 line 32 and column 31 lines 1-10 and Figs. 9-11).

As to claim 4, Williams teaches the querying step includes a payment instrument selected by the user (Figs. 9-11).

As to claim 5, Williams authenticating an identification of the user (column 17 lines 41-47 and Fig. 9).

As to claim 7, Williams teaches processing the transaction using a payment instrument that includes a financial component or a non-financial component (abstract).

As to claim 8, Williams teaches permitting the user to decline at least one of the one or more payment systems (column 31 lines 18-20 and Figs. 11, 13).

As to claim 10, Williams teaches identifying the one or more payment systems by corresponding routing information (column 16 lines 44-58).

As to claim 13, Williams teaches entering into a contract with the at least one payment system for processing the transaction (Figs. 11-12).

As to claim 21, Williams teaches selecting the one or more payment systems based upon preferences of the user (column 17 lines 52-54).

Claims 11-12, 14-16 and 18-20 are in parallel with the limitations in claims 1-5 and 7-8; thus, they are rejected on the same basis.

5. Claims 6 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al., US 5,815,657 in view of Randell et al., US 2004/0064375 A1, and in further view of Rose et al., US 5,757,917.

As to claims 6 and 17, Williams modified by Randell does not specifically teach negotiating with the payment system a price for the requested item or associated fees. However, Rose discloses a computerized payment system for purchasing goods and services online where the buyer and seller may use the payment system to negotiate a price for a good or service (column 7 lines 48-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow teaching of Williams modified by Randell to include the negotiation feature as taught by Rose so that the buyers may receive deal and the sellers may increase sales.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al., US 5,815,657 in view of Randell et al., US 2004/0064375 A1, and in further view of Campbell et al., US 2002/0023033 A1.

As to claim 9, Williams modified by Randell does not specifically teach identifying, along with the one or more located payments, a rating indicating how closely the one or more payment systems match the payment criteria. However, Campbell teaches ranking the matched criteria (see ¶ 115 and claim 5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the payment criteria to be ranked so that the user can have better view of the matched result.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/611,034. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both disclose querying a direct of payment systems to locate at least one payment system to process transactions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Inquire***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (571)-272-6705. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (571) 272-6712.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(571) 273-8300      (Official Communications; including After Final  
Communications labeled "BOX AF")



Art Unit: 3694

(571) 273-6705 (Draft Communications)

/Mary Cheung/  
Primary Examiner, Art Unit 3694  
April 1, 2008